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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,242	09/30/1999	RAHUL R. VAID	61582-00001USPT	5090
7590	01/22/2004		EXAMINER	
Gary B. Solomon Jenkens & Gilchrist P. C. Suite 3200 1445 Ross Avenue Dallas, TX 75202-2799			MORGAN, ROBERT W	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 01/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/409,242	VAID, RAHUL R.
	Examiner	Art Unit
	Robert W. Morgan	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 November 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 and 34-75 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 and 34-75 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 11/6/03, paper number 19.

Claims 57-75 have been added. Now claims 1-16 and 34-75 are presented for examination.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 65-74 been renumbered 66-75, as well as renumbering the corresponding dependencies.

### ***Claim Rejections - 35 USC § 101***

3. The rejection under 35 U.S.C. 101 to claims 1-16, 34-43, 50 and 52-54 has been maintained for same reasons given in the previous Office Action (paper number 17).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11, 14-16, 34-38, 41 and 44-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,897,620 to Walker et al. in view of "Hawaiian Air to Offer

Tickets Through ATMs" by Wall Street Journal, for the substantially same reason given in the previous Office Action (paper number 17). Further reasons appear below.

As per claim 57, Walker et al. and Wall Street Journal teach the claimed identifier is operable to book a seat on a flight from one of multiple air travel air carriers. This limitation is met by Hawaiian Air that plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: Wall Street Journal: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency. The customer will need to contact Hawaiian Air to reserve space on their desired flight (see: Wall Street Journal: paragraph 4). Since Hawaiian Air is issuing "open tickets" which are valid for year the skilled artisan expects an "open ticket" to include an identifier operable to book a seat on a flight from one of multiple air travel air carriers such Hawaiian Air.

As per claim 58, Walker et al. and Wall Street Journal teach the claimed seat costs at most the fixed price. This feature is met by Hawaiian Air that plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: Wall Street Journal: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency (see: Wall Street Journal: paragraph 4). In addition, Walker et al. and Wall Street Journal teach an unspecified-time airline tickets corresponding to a special fare (see: Walker et al.: column 2, lines 25-29).

As per claim 59, Walker et al. and Wall Street Journal teach the claimed fixed price is below market price. This feature is met by Hawaiian Air that plans to allow customer and non-

customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: Wall Street Journal: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency (see: Wall Street Journal: paragraph 4). In addition, Walker et al. and Wall Street Journal teach an unspecified-time airline tickets corresponding to a special fare (see: Walker et al.: column 2, lines 25-29).

As per claims 60 and 63, they are rejected for the same reasons set in claim 58.

As per claim 61, Walker et al. and Wall Street Journal teach the claimed seat costs at most pre-paid payment. This feature is met by Hawaiian Air that plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: Wall Street Journal: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency (see: Wall Street Journal: paragraph 4). In addition, Walker et al. and Wall Street Journal teach an unspecified-time airline tickets corresponding to a special fare (see: Walker et al.: column 2, lines 25-29).

As per claim 62, Walker et al. and Wall Street Journal teach the claimed pre-paid payment is below market price. This feature is met by Hawaiian Air that plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: Wall Street Journal: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency (see: Wall Street Journal: paragraph 4). In

addition, Walker et al. and Wall Street Journal teach an unspecified-time airline tickets corresponding to a special fare (see: Walker et al.: column 2, lines 25-29).

As per claims 63-65, they repeat the subject matter of claims 60-62, as a set of “computer program” elements rather than method. As the underlying processes of claims 60-62 has been shown to be obvious in view of the teachings of Walker et al. and Wall Street Journal in the above rejections of claims 60-62, it is readily apparent that the system disclosed by Walker et al. and Wall Street Journal includes a computer program to perform these functions. As such, these limitations are rejected of the same reasons given above for method claims 44, 63 and 64, and incorporated herein.

As per claim 66, Walker et al. teaches a unspecified-time ticket that includes receiving identification of flight information such as destination location and departure times, special fares and also receiving information regarding booking a ticket at the special fares (see: column 3, lines 1-11).

Walker et al. fails to teach the claimed advance-purchase of an airline ticket for a fixed price including an identifier utilized by the customer to book the flight from one of the multiple air travel carriers offering flights including seating available to be purchased using the pre-paid airline ticket at the fixed price.

Wall Street Journal teaches that Hawaiian Air plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons (reads on “pre-paid airline ticket for a fixed price to be utilized by a customer to book a flight”) through the bank’s ATMs 24 hours a day using a card issued by the bank or a major credit card (see: paragraph 4). Furthermore, the coupon or “open ticket” will be valid for a year and will cost the same as those purchase from the airline or travel

agency. The customer will need to contact Hawaiian Air to reserve space on their desired flight (see: paragraph 4). Since Hawaiian Air is issuing “open tickets” which are valid for year the skilled artisan expects an “open ticket” to include an identifier uniquely identifying the pre-paid airline ticket and operable to be utilized by the customer to book a flight.

The obviousness of combining the teachings of Wall Street Journal within Walker et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claims 67-70, Walker teaches the claimed a plurality of geographic flight parameters, at least one of the geographic flight parameters is unspecified, geographic flight parameters include regions and airports. These limitations are met by the unspecific-time ticket that includes receiving identification of flight information such as destination location and departure times, special fares and also receiving information regarding booking a ticket at the special fares (see: column 3, lines 1-11).

As per claims 71 and 72, Walker teaches the claimed a plurality on non-geographic flight parameters and the non-geographic flight parameters are unspecified. These features are met by the flight schedule database (240, Fig. 2) that contains flight information including departure date, flight number and flight times and the seat allocation database (245, Fig. 2) that contains seat information (see: column 7, lines 35-41 and column 10, lines 13-15). In addition, Walker teaches that the unspecified-time tickets include flexibility regarding the origin (if there are one or more airport in the area local to the traveler) and the destination (is there more than one airport accessible for the traveler’s ultimate destination) to select the best flight at a certain price. The origin and destination of the unspecified-time tickets are all examples of the non-geographic flight parameter (see: column 12, lines 28-44).

As per claim 73, Walker teaches the claimed information identifying the customer. This limitation is met by the passenger name record (1030, Fig. 10) (see: column 10, lines 26-35).

As per claims 74 and 75, they are rejected for the same reasons set forth in claims 59 and 58, respectively.

6. Claims 12-13 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,897,620 to Walker et al. in view of U.S. Patent No 5,953,705 to Oneda, for the same reason given in the previous Office Action (paper number 17).

7. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,897,620 to Walker et al., for the same reason given in the previous Office Action (paper number 17).

***Response to Amendment***

8. Applicant's arguments filed 11/6/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 11/6/03.

(A) In the remarks, Applicants argue in substance that, (1) the rejection under 35 USC § 101 is improper because the claims are drawn to an abstract idea, and that they also produce a useful, concrete, and tangible result; (2) Examiner fails to establish a *prima facie* case of obviousness using the three basic criteria; and (3) there is no suggestion or motivation to combine the reference of Walker with Wall Street Journal and using the open ticket of Hawaiian Air in the ticketing system of Walker, renders Walker inoperable.

(B) At page 14, Applicant argues the rejections made under 35 USC 101, and relies on the court decision in *State Street Bank & Trust Co v. Signature Financial Group* for support that

“a process … employing … [an] abstract idea is patentable subject matter even though … [an] abstract idea would not, by itself, be entitled to such protection.”

In response, it is respectfully submitted that Applicant takes the cited passage from the *State Street* decision out of context. In particular, the passage relied upon by Applicant appears to directed to an explanation on why the application of a particular test, the Freeman-Walter-Abele test, for determining statutory subject matter was misleading. Note the quoted passage in its entirety, as given hereinbelow for Applicant’s convenience:

“After *Diehr* and *Chakrabarty*, the Freeman-Walter-Abele test has little, if any, applicability to determining the presence of statutory subject matter. As we pointed out in *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1557, application of the test could be misleading, because a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection.”

As such, since no such test was applied to Applicant’s claimed invention, the cited passage has no relevance to the issues at hand.

Further, it is noted that the Examiner rejection was not based on the fact the claimed process is NOT useful, tangible, or concrete, nor that claimed process lacks a practical application, *per se*. Rather, the basis of the Examiner’s rejection was that the recited claims were not directed to a practical application in the technological arts. With regard to this issue, it is noted that Applicant’s presently recited claims do not even rise the level of the claims under review by the Federal Circuit in the *State Street Bank* decision, which clearly and explicitly recite a practical application in the technological arts. Note, for example, the format and language of claim 1 in the *State Street Bank* decision, provided hereinbelow:

1. A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:
  - (a) computer processor means [a personal computer including a CPU] for processing data;
  - (b) storage means [a data disk] for storing data on a storage medium;
  - (c) first means [an arithmetic logic circuit configured to prepare the data disk to magnetically store selected data] for initializing the storage medium;
  - (d) second means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases or decreases based on specific input, allocate the results on a percentage basis, and store the output in a separate file] for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;
  - (e) third means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;
  - (f) fourth means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and
  - (g) fifth means [an arithmetic logic circuit configured to retrieve information from specific files, calculate that information on an aggregate basis and store the output in a separate file] for processing data regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds.

As such, it is respectfully submitted that Applicant's reliance on the *State Street Bank* decision is not persuasive, as Applicant's presently recited claims clearly lack a practical application in the technological arts in a manner consistent with the claims reviewed by the Federal Circuit in their decision.

Moreover, the Examiner is concerned that Applicant apparently ignores the mandate of other court decision that clearly support the Examiner's position. For example, the court in *In re Toma* stated: " 'technological' or 'useful' arts inquiry must focus on whether claimed subject matter, for example, method of operating machine to translate, is statutory, not on whether

product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example, whether it ‘enhances’ operation of machine; this was law prior to *Gottschalk v. Benson*, 175 USPQ 673, and was not changed by *Benson*.” (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that “... all that is necessary to make a sequence of operational steps a statutory ‘process’ within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with Constitutional purpose to promote progress of ‘useful arts’ ...” (emphasis added).

In sum, it is respectfully submitted that the Examiner’s rejection of the claims under 35 USC 101 is indeed proper and should be maintained for at least the reasons given above and the guidance of appropriate case law.

(C) In response to Applicants argument that, (2) Examiner fails to establish a *prima facie* case of obviousness using the three basic criteria; and (3) there is no suggestion or motivation to combine the reference of Walker with Wall Street Journal and using the open ticket of Hawaiian Air in the ticketing system of Walker, renders Walker inoperable. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see: paper number 17).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (paper number 6), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the motivation to combine the teachings of the Wall Street Journal within Walker et al. reference as given on page 5 of the previous Office Action (paper number 17) is suggested in a passage from the Wall Street Journal paragraph 2, “airline passengers bent on convenience, here is something at least as user-friendly as electronic ticketing: buying plane tickets at an automated teller machine”.

With regards to Applicant's assertion that the proposed modification of the Wall Street Journal within Walker would render the Walker reference unsatisfactory for its intended purpose, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM  
rwm

*Robert W. Morgan  
Alexander Kukorski  
Primary Examiner  
Art Unit 3626*